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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095				
			EXAMINER AUGHENBAUGH, WALTER	
			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,621

Applicant(s)

MILLIORN ET AL.

Examiner

Walter B Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12-18,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12-18,21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 10, 2003 (Paper 14) has been entered.
2. The amendments made in claims 1 and 15 in Paper 14 have been received and considered by Examiner.
3. Claims 8, 11, 19, 20, 22 and 24-28 were previously cancelled in the Amendment filed January 22, 2003 (Paper 6).

WITHDRAWN REJECTIONS

4. The 35 U.S.C. 103 rejection of claims 15-18 over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicant made of record in paragraph 11 of Paper 7 has been withdrawn due to Applicant's amendment to claim 15 in Paper 14.
5. The 35 U.S.C. 103 rejection of claims 21 and 23 over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicants made of record in paragraph 12 of Paper 5 and repeated in Paper 7 has been withdrawn due to Applicant's amendment to claim 15 in Paper 14.

REPEATED REJECTIONS

6. The 35 U.S.C. 103 rejection of claims 1-7 over Oosterlinck in view of Warther is repeated for the reasons previously made of record in paragraph 10 of Paper 5 and for the following reasons that address the amendments made to claim 1 in Paper 14: the structure recited by the phrase “to form a plurality of cut triangular shaped labels”, i.e. “a plurality of triangular shaped labels”, is taught by the combination of Oosterlinck and Warther as previously made of record in paragraph 10 of Paper 5. The addition of the term “shaped” immediately prior to the word “labels” in the last two lines of the claim does not introduce new structure.

7. The 35 U.S.C. 103 rejection of claim 9 over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicants is repeated for the reasons previously of record in paragraph 12 of Paper 5.

8. The 35 U.S.C. 103 rejection of claims 10 and 12 over Oosterlinck in view of Warther and in further view of admitted prior art of Applicants is repeated for the reasons previously of record in paragraph 13 of Paper 5.

9. The 35 U.S.C. 103 rejection of claims 13 and 14 over Oosterlinck in view of Warther and in further view of admitted prior art of Applicants is repeated for the reasons previously of record in paragraph 15 of Paper 5.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

10. Claims 15-18, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over St. Aubin in view of the admitted prior art of Applicant (“Background of the Invention” section of Applicants’ specification).

In regard to claim 15, St. Aubin teaches an adhesive label comprising a triangular shaped adhesive label having a first, second and third side of equal length (equilateral triangular shaped separable portion of the label, item 29, col. 3, lines 19-21 and 35-45, col. 5, lines 12-15 and Fig. 4). St. Aubin teaches that the label includes a face material (item 15), an adhesive layer (item 26) and a liner (carrier web, item 14) (col. 2, lines 15-28 and 50-56 and Fig. 2 and 4). St. Aubin teaches that the adhesive layer entirely covers the side of the face material adjacent the liner (col. 2, lines 51-54, col. 3, lines 43-45 and Fig. 2 and 4).

St. Aubin fails to teach that the face material includes text selected from a group consisting of text found in day of the week first in first out food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems.

However, Applicant discloses that these three food safety labeling systems are notoriously well known to those of ordinary skill in the food safety labeling art in paragraph [0003] of the "Background of the Invention" section of Applicants' specification (page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided text consisting of text found in day of the week first in first out food safety labeling systems, text relating to shelf-life/product identification food safety labeling systems and text relating to use by/use first food safety labeling systems to the label of St. Aubin since it is notoriously well known to provide text consisting of text used in the aforementioned food safety labeling systems as taught by the admission of Applicants.

In further regard to claim 15, the phrase "whereby the triangular shaped label is used in food safety labeling systems utilized by food services industries" is an intended use phrase that

Art Unit: 1772

has not been given patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987).

In regard to claim 16, while St. Aubin does not explicitly teach the material of the face material, Applicant discloses that the face material of adhesive labels is most commonly paper, and that polyester, vinyl, polypropylene and foil are also suitable materials as the material of a face material of adhesive labels (lines 5-6 of paragraph [0005], page 2, of the "Background of the Invention" section of Applicants' specification). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used paper, polyester, vinyl, polypropylene or foil as the face material of the label of St. Aubin since paper, polyester, vinyl, polypropylene and foil are notoriously well known label face materials as taught by the admission of Applicants.

In regard to claim 17, St. Aubin teaches that the adhesive layer is formed from a permanent adhesive (col. 3, lines 43-45).

In regard to claim 18, while St. Aubin does not explicitly teach that the liner is a silicone-coated sheet of paper, St. Aubin does teach that the liner (carrier web, item 14) has a release coating (item 25, Fig. 2) on the surface of the liner that is in contact with the adhesive layer (item 26) that is configured to allow the face material and the adhesive layer to be removed from the liner (col. 2, lines 26-28 and 50-51). Applicant discloses that a silicone-coated sheet of paper is a known adhesive label liner (lines 11-12 of paragraph [0005], page 2, of the "Background of the Invention" section of Applicants' specification). Therefore, it would have been obvious to one of

Art Unit: 1772

ordinary skill in the art at the time the invention was made to have used a silicone-coated sheet of paper as the liner of St. Aubin since a silicone-coated sheet of paper is a notoriously well known label liner material as taught by the admission of Applicants.

In regard to claims 21 and 23, St. Aubin fails to teach that the printing of the plurality of labels includes printing color on the plurality of labels (in regard to claim 21) or the particular colors corresponding to the days of the week in the industry standard color code system (in regard to claim 23). However, Applicants disclose that the claimed different color for each day of the week system is an “industry standard color code system” (lines 3-7 of paragraph [0003], page 1, of the “Background of the Invention” section of Applicants’ specification). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided color to the labels St. Aubin according to the industry standard color code system used in food safety labeling systems since it is notoriously well known to apply colors to labels according to the industry standard color code system used in food safety labeling systems as taught by the admission of Applicants.

ANSWERS TO APPLICANT’S ARGUMENTS

11. Applicant’s arguments in Paper 14 regarding the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper 5 and repeated in Paper 7 and in this Office Action (Paper 15) have been fully considered but are not persuasive.

In response to Applicant’s assertion that “Warther teaches away from the desirability of making triangular-shaped labels” (page 6 of Paper 14), the tags taught by Warther and shown in Figure 3 (tag elements 50A-50X, col. 3, lines 33-41) are triangular-shaped labels because the tags are adhered to a substrate (the magnetizable strips, items 31-34) via an adhesive layer (col.

9, lines 50-51) and are therefore labels. Consequently, Warther does not teach “away from the desirability of making triangular-shaped labels”.

In response to Applicant’s argument that Oosterlinck “suggests no shapes of labels which are possible”, there is nothing written in paragraph 10 of Paper 5 that alleges this. Warther teaches the claimed label shape.

Applicant’s argument that “nor does [Oosterlinck] teach or suggest a scoring step” at the top of page 7 of Paper 14 and all subsequent arguments that rely upon method limitations are irrelevant because the method of forming the label is not germane to the issue of patentability of the label itself. The determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

Applicant’s argument that “The transparent layers are adhered to the core by means of an adhesive appropriate for use with the specific core material. These transparent layers are permanently adhered to the core” is not directed to how the subject matter of this argument is distinguishable from the language of the instant claims; these limitations, in fact, read on the instant claims.

Applicant’s argument that “there is no teaching or suggestion of an adhesive layer and a liner/release paper covering the entire sheet” is irrelevant, because the limitation that Applicant relies on, “an adhesive layer and a liner/release paper covering the entire sheet”, is not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not

Art Unit: 1772

specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Applicant then states that the “liner, and magnetic strips [of Warther] share no common or equivalent function”; Examiner disagrees, the magnetic strips of Warther are structurally equivalent to the liner as claimed. Applicant’s argument that “Warther is silent as to how his scored sheets are made” is irrelevant since this argument relies on the method of forming the article. Applicant’s argument in the first full paragraph of page 8 of Paper 14, again, is based on the method of making the article, which is irrelevant.

Applicant’s assertions that “the shaped tags of Warther are not formed from a face web, an adhesive layer and a backing/release layer” and a “sheet, including the tag, is never taught or suggested as coverable with an adhesive layer and a backing layer” on page 8 of Paper 14 are incorrect. The laminate of the core (item 12) and transparent layers (items 20 and 22) corresponds to the “face web”, magnetizable strips (items 31-34) correspond to the “backing/release layer” and the magnetizable strips (items 31-34) are applied to a transparent layer (item 20 or 22) with an adhesive as taught by Warther (col. 9, lines 50-51) that corresponds to the “adhesive layer”. Applicant’s argument that the shaped tags of Warther “are [not] cut from a face web to form separate labels as required by Oosterlinck: Warther only teaches scoring sheets” is irrelevant since the method of forming the label is not germane to the issue of patentability of the label itself. The determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946,

Art Unit: 1772

966 (Fed. Cir. 1985) and MPEP §2113. The magnetizable strips (items 31-34) correspond to the liner as claimed.

Applicant argues that the “liner layer in Warther is in fact permanently attached”; however, Warther does not teach this. Applicant’s argument that the references cannot be combined since the function of both references would be destroyed if combined since the “liner layer in Warther is in fact permanently attached” is consequently baseless. Applicant argues that “If these strips were removable then the function of Warther would be destroyed”, but the “function of Warther” is a matter of the intended use of the article; it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Applicant argues that “these strips are required for the Warther invention to work”, but Warther never discloses that the strips are required to be permanently attached to the tags. In response to Applicant’s question “Why would they be removable?”, Warther does not disclose that the strips are required to be permanently attached to the tags and does not disclose that the strips are required to not be removable. The tags are labels because they are adhered to a substrate (the strips) via an adhesive.

In response to Applicant’s argument that since “Warther considers triangle shapes as difficult to remove from a scored sheet and he prefers to make more rectangularly shaped removable elements”, “one of ordinary skill [would not] look to this reference for guidance into making a triangular-shaped label that has a liner” on page 9 of Paper 14, this teaching does not supercede Warther’s teaching of maximizing the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41)

Art Unit: 1772

by arranging triangular-shaped labels as shown in Figures 1 and 3 of Warther. Eventhough, “Warther considers triangle shapes as difficult to remove from a scored sheet” as pointed out by Applicant, Warther nonetheless arranges triangular-shaped labels as shown in Figures 1 and 3 in order to maximize the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41). One of ordinary skill in the art is amply motivated to combine the references to arrive at a maximum number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size as taught by Warther. In response to Applicant’s question of “How can there be any expectation of success for this proposed combination of references?”, Warther nonetheless arranges triangular-shaped labels as shown in Figures 1 and 3 in order to maximize the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41); and therefore, the “expectation of success” that Applicant presumably alleges is lacking is that the number of tag elements on a given sheet would be maximized as taught by Warther. Again, one of ordinary skill in the art is amply motivated to combine the references to arrive at a maximum number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size as taught by Warther.

Applicant’s assertion that “the only potential teaching for [the motivation for combining the references] is clearly Applicant’s own patent application” is not the case. Both Oosterlinck and Warther disclose labels, and Warther clearly teaches the arrangment of triangular-shaped labels as shown in Figures 1 and 3 in order to maximize the number of tag elements

Art Unit: 1772

(equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41).

12. Applicant's arguments in Paper 14 regarding the 35 U.S.C. 103 rejection of claim 9 made of record in Paper 5 and repeated in Paper 7 and in this Office Action (Paper 15) have been fully considered but are not persuasive. Applicant's arguments regarding the rejection to these claims rely entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper 14 that are addressed above.

13. Applicant's arguments in Paper 14 regarding the 35 U.S.C. 103 rejection of claims 10 and 12 made of record in Paper 5 and repeated in Paper 7 and in this Office Action (Paper 15) have been fully considered but are not persuasive. Applicant's arguments regarding the rejection to these claims rely entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper 14 that are addressed above.

14. Applicant's arguments in Paper 14 regarding the 35 U.S.C. 103 rejection of claims 13 and 14 made of record in Paper 5 and repeated in Paper 7 and in this Office Action (Paper 15) have been fully considered but are not persuasive. Applicant's arguments regarding the rejection to these claims rely entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper 14 that are addressed above.

15. Applicant's arguments in Paper 14 regarding the 35 U.S.C. 103 rejection of claims 15-18 made of record in Paper 7 are rendered moot due to the withdrawal of the 35 U.S.C. 103 rejection of claims 15-18 over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicant made of record in Paper 7 in this Office Action (Paper 15).

Art Unit: 1772

16. Applicant's arguments in Paper 14 regarding the 35 U.S.C. 103 rejection of claims 21 and 23 made of record in Paper 7 are rendered moot due to the withdrawal of the 35 U.S.C. 103 rejection of claims 21 and 23 over Oosterlinck in view of Warther and in further view of Kirk and in further view of admitted prior art of Applicant made of record in Paper 7 in this Office Action (Paper 15).

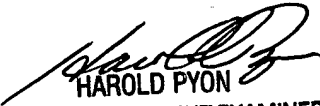
Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
10/15/03 WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/17/03